REMARKS

This amendment is responsive to the office action dated March 2, 2006. Claims 15-19 stand allowed and claims 1-14 and 20 stand rejected. The claims are rejected based on 35 U.S.C. Section 103 as obvious. Reconsideration of the rejected claims is respectfully requested based on the amendments above and the argued urged below.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-15 and 20 under 35 U.S.C. §103(a) as being unpatentable over Fascenda in view of Tsimelzon. Applicants have amended independent claims 1 and 20 to more particularly point out and distinctly claim the subject matter regarded as the invention. In particular, claims 1 and 20 have been amended to recite that the table of data comprises "parameters characteristic of capabilities of the palmtop computer including resolution and color characteristics of a display of the palmtop computer.

The present invention, as recited in claims 1 and 20, is directed to a method of adapting content for delivery to a palmtop or like portable computer. In particular, web content is delivered to the palmtop computer after a profile of the palmtop computer is selected from a table of data. In particular, the table of data contains parameters characteristic of the capabilities of the each individual palmtop or like portable computer so that the web content can be delivered in the most efficient manner. For example, in recognition of palmtop computer's specific display mode, processor power, latency, connection speed, etc., web content is particularized for each palmtop computer. In this way, maximum transmission efficiency is achieved for each particular palmtop computer. Importantly, the user of the palmtop computer does not have to express a preference for certain transmission characteristics of the web content to his palmtop computer. The transmission characteristics are automatically selected based on the self-identification of the palmtop computer (either through serial number transmission or header information to the web content proxy server).

Neither Fascenda nor Tsimelzon recognize or discuss the problem that certain formats of content may be more efficiently transmitted to certain wireless devices. Fascenda is directed to a system for automatically updating options available to a client

device operating in a client-server environment. Client devices are automatically reconfigured for applications downloaded to the client device. However, Fascenda does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer. Tsimelzon is directed to a method for user creating a short web page based on an original web page including retrieving user selected blocks and non-retrieving non-user selected blocks. Again, Tsimelzon does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer.

Therefore, Applicants respectfully submit that a combination of Fascenda and Tsimelzon does not teach or suggest every claimed feature of the invention as defined by claims 1, 9, 11-14, and 20.

The Examiner further rejected claims 2-8 under 35 U.S.C. Section 103(a) as unpatentable over Fascenda in view of Tsimelzon as applied to claim 1 and further in view of Robotham et al. The Examiner asserts that Robotham discloses particular characteristics of the palmtop computer. Claims 2-8 depend on claim 1 and should be allowable at least by virtue of the reasons by which claim 1 is allowable. Moreover, neither Fascenda, Tsimelzon, nor Robotham recognize or discuss the problem that certain formats of content may be more efficiently transmitted to certain wireless devices. Fascenda is directed to a system for automatically updating options available to a client device operating in a client-server environment. Client devices are automatically reconfigured for applications downloaded to the client device. However, Fascenda does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer. Tsimelzon is directed to a method for user creating a short web page based on an original web page including retrieving user selected blocks and non-retrieving non-user selected blocks. Again, Tsimelzon does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer. Robotham is directed to display of visual content on a client device using server-side rasterization of visual content. Again, Robotham does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer.

Therefore, Applicants respectfully submit that a combination of Fascenda, Tsimelzon and Robotham does not teach or suggest every claimed feature of the invention.

The Examiner has rejected claim 10 as unpatentable over Fascenda in view of Tsimelzon as applied to claim 1 and further in view of Britton. Claim 10 depends on claim 1, which is distinct for the reasons urged above. Accordingly, claim 10 is distinct at least for the reasons urged with respect to claim 1. Moreover, neither Fascenda, Tsimelzon, nor Britton recognize or discuss the problem that certain formats of content may be more efficiently transmitted to certain wireless devices. Fascenda is directed to a system for automatically updating options available to a client device operating in a client-server environment. Client devices are automatically reconfigured for applications downloaded to the client device. However, Fascenda does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer. Tsimelzon is directed to a method for user creating a short web page based on an original web page including retrieving user selected blocks and non-retrieving non-user selected blocks. Again, Tsimelzon does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer. Britton is directed to distribution of tailoring functions between data processing systems based on session specific information. Again, Britton does not disclose or suggest web content automatically selected based on the self-identification of the palmtop computer.

Applicants urge the Examiner to reconsider the 35 U.S.C Section 103 rejections in view of the reasoning discussed below. For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a prima facie case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35

U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the <u>same</u> problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,
BERRY & ASSOCIATES P.C.

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